The opinion in support of the decision being entered today was ***not*** written for publication and is ***not*** binding precedent of the Board.

Paper No. 40

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte GEORGE TASH

Appeal No. 2004-1604
Application 08/637,894

ON BRIEF

Before KIMLIN, WARREN, and TIMM, *Administrative Patent Judges.*

WARREN, *Administrative Patent Judge.*

REMAND TO THE EXAMINER

We remand the application to the examiner for consideration and explanation of issues raised by the record. 37 CFR § 1.196(a) (2003); Manual of Patent Examining Procedure (MPEP) § 1211 (8th ed., Rev. 2, May 2004; 1200-29 – 1200-30).

The record shows that three grounds of rejection were set forth by the examiner in the final Office action mailed April 9, 2003 (Paper No. 29; pages 3-5):

claims 10, 11, 13, 14, 16, 1, 2, 6 and 9 are rejected under 35 U.S.C. § 102(b) as being anticipated by Scarella;

claims 12, 15, 17, 3 and 4 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Scarella and Tash; and

claims 10 through 17, 1 through 4, 6 and 9 are provisionally rejected under 35 U.S.C. § 103(a) as being unpatentable over Scarella and Tash as applied to claims 10 through 17, 1 through 4, 6 and 9 above, and further in view of Locke.

In the brief, appellant includes all of the three grounds of rejection under the heading "Issues," and under the heading "Grouping Of Claims," appellant states that "[c]laims 1-4, 6 and 9-17 stand or fall together." Appellant presents arguments with respect to each and every ground of rejection, without separately arguing any specific appealed claim (*id.*, pages 5-13).

In the answer, the examiner states with respect to "Issues":

> The appellant's statement of the issues in the brief is substantially correct The changes are as follows: Appellant appears to indicate the presence of three issues. However, only one issue, involving claim anticipation over the Scarella reference, remains on appeal due to appellant's request that claims 1-4, 6 and 19-17 stand or fall together. [Page 3.]

Thus, in the answer, the examiner states a sole ground of appeal: "Claim 10 (and claims 1-4, 6, 9 and 11-17 as standing or falling therewith) is rejected under 35 U.S.C. 102(b) as being anticipated by Scarella," stating the rejection in the same manner as in the final to the extent that the subject matter of claim 10 is involved (page 4).

The examiner states no reason for now including appealed claims 3, 4, 12, 15 and 17 in the ground of rejection under § 102(b) in the answer (*id.*). Such reasoning would be necessary to support the rejection of these appealed claims under this statutory provision in the answer because in the final rejection, a secondary reference, Tash, was deemed necessary to account for the differences between the claimed invention encompassed by these claims and the disclosure of Scarella (Paper No. 29; page 4). It goes without stating that a ground of rejection under this statutory provision in which the statement of the rejection does not include reasons establishing that as a matter of fact each of the rejected claims is *prima facie* anticipated, is summarily not sustainable with respect to the claims for which *no* attempt is made to establish a *prima facie* case.

In any event, it is manifest that the ground of rejection under § 102(b) stated at page 4 of the answer is indeed a new ground of rejection with respect to appealed claims 3, 4, 12, 15 and 17, and is improperly included in the answer because a new ground of rejection is prohibited in an answer. MPEP § 1208.01 (8th ed., Rev. 2, May 2004; 1200-24 – 1200-25).

The action by the examiner based on appellant's statement grouping the appealed claims which is not specific with respect to any ground of rejection, all grounds of rejection being

argued without specifying a claim with respect to any ground, is also improper as it denies appellant due process. In this respect, 37 CFR § 1.192(c)(7)(2003) states in pertinent part (underlining emphasis supplied):

> (7) *Grouping of claims*. For each ground of rejection which appellant contests and which applies to a group of two or more claims, the Board shall select a single claim from the group and shall decide the appeal as to the ground of rejection on the basis of that claim alone unless a statement is included that the claims of the group do not stand or fall together and, in the argument under paragraph (c)(8) of this section, appellant explains why the claims of the group are believed to be separately patentable.

See also MPEP § 1206 (8th ed., Rev. 2, May 2004; 1200-10 – 1200-11).

Furthermore, it is the practice for the examiner to include in the answer a statement and explanation of each ground(s) of rejection advanced on appeal, and a response to appellant's argument(s) with respect to each ground(s) of rejection set forth in the brief. 37 CFR § 1.193(a)(1) (2003); MPEP § 1208 (8th ed., Rev. 2, May 2004; 1200-16 – 1200-19).

In the present appeal, there is no basis in any rule or practice on which to fairly construe appellant's bare statement that the appealed claims "stand or fall together" as an admission that *all* appealed claims stand or fall together with respect to any particular ground of rejection, regardless of whether that ground includes all of the appealed claims. Indeed, in this case, such a position is clearly without merit in view of the separate arguments presented for *each* of the grounds of rejection that are not specific to any appealed claim.

Accordingly, the examiner is required to take appropriate action consistent with current examining practice and procedure to either reopen prosecution based on the new ground of rejection under § 102(b) stated in the answer, or submit a supplemental answer setting forth each ground of rejection of record that is to be maintained on appeal and a response with respect to the arguments made by appellant with respect to each ground of rejection advanced, with a view toward placing this application in condition for decision on appeal with respect to the issues presented.

We hereby remand this application to the examiner, via the Office of a Director of the Technology Center, for appropriate action in view of the above comments.

This application, by virtue of its "special" status, requires immediate action. § 708.01(D) (8th ed., Rev. 2, May 2004; 700-127). It is important that the Board of Patent Appeals and Interferences be informed promptly of any action affecting the appeal in this case. *See, e.g.,* MPEP§ 1211 (8th ed., Rev. 2, May 2004; 1200-30).

Remanded

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